

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit: 1713

Hans-Peter-Weitzel et al.

Examiner: Kelechi Chidi Egwim

Serial No.: 10/692,887

Filed: October 24, 2003

For: Protective-Colloid-Stabilized Polymers In The Form Of Their
Aqueous Dispersions Or Of Their Water Redispersible Powders

Attorney Docket No.: WAS 0606 PUS

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
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Sir:

This Reply Brief is in response to the Examiner's Answer mailed on October 10, 2006 for the above-identified patent application.

The Examiner alleges the brief to be deficient because:

. . .the present claims only require the partially hydrolyzed EVA polymers to be used, at some point, during preparation of the powder. There is no limitation requiring the same protective colloid to be used in both the polymerization step and the subsequent addition of protective colloid before drying.
Answer, page 3 (Emphasis Added).

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This allegation is wholly and factually incorrect.

The Examiner further states in this respect:

There is also no actual requirement in the appealed claims that the further addition of protective colloid be during spray drying.
Cite.

The support section V referred to by the Examiner does not contain this language!

The claim requires that an EVA protective colloid by used during polymerization and during drying by adding prior to drying. Any attempt to misconstrue this clear language is disingenuous. The relevant portions of the claim read as follows:

“ . . . wherein said polymer is prepared. . . in the presence of A PROTECTIVE COLLOID and drying of the polymer dispersion thus obtained after addition of FURTHER PROTECTIVE COLLOID, wherein partially hydrolyzed [EVA] copolymers. . . ARE used as the PROTECTIVE COLLOIDS.

(Claim 11, Emphasis Added).

This language clearly indicates that the protective colloid used in the polymerization and the protective colloid added prior to drying (thus containing (employing) protective colloid during drying) are each a partly hydrolyzed EVA copolymer. This is not a question where there is an undefined or ambiguous claim term nor a question of whether there is support for a term used in the claim.¹ It is a question of English grammar. The grammatical construction is clear.

¹ There is clear support for Applicants' claim construction in the specification, including the preparation of powders 1 and 2 on page 17 which exactly follow the claimed procedure.

If one states: “Fred has a Ford and a Chevy; the cars are red.” This means that both cars (plural) are red. The word “both” does not have to be used in the original sentence to make the meaning clear.

If one states: “Sally ate a pastrami-on-rye sandwich while Joe ate a roast beef sandwich; the sandwiches are from the Stage Deli.” This means that both sandwiches (plural) are from the Stage Deli. The word “both” does not have to be present in the original sentence for this meaning to be clear.

Here, the claim requires “a protective colloid” and a “further protective colloid”, and then states “the protective colloids (plural) are (plural verb as well) partly hydrolyzed EVA copolymers. This claim is only amenable to one grammatical construction: that both the polymerization protective colloid and the drying protective colloid are partly hydrolyzed EVA copolymers. The word “both” does not have to appear for the claim to have this meaning.

Moreover, when this claim amendment was first presented in Appellants’ Amendment Under 37 C.F.R. § 1.111 dated December 13, 2005, Appellants stated:

The claims now [as amended] require that the EVOH protective colloid be used for both polymer preparation by emulsion or suspension polymerization, as well as in spray drying, as exemplified by powders 1 and 2 on page 17 of the application.
Amendment under 37 C.F.R. § 1.111, p. 5.

Further in the Amendment, Appellants emphasized:

Applicant’s claims require that EVOH protective colloids be employed both during polymerization and during spray drying
. . .

Amendment Under 37 C.F.R. § 1.111, page 6.

However, the Examiner disregarded both the plain meaning of the claim as well as Appellants' statement of what the language means (which ordinarily should have been superfluous). The Examiner does not have the right to do this based both on professional and common sense grounds, as well as binding legal precedent, as discussed hereinafter.

Appellants offered to amend the claim to insert "both" to expedite prosecution, although the clear meaning does not require it, and although the scope of the claim would not have been changed thereby. Appellants did not actually make this amendment because, based on past experience, Appellants believed that the amendment would not be entered, and the Examiner has confirmed that this would have been the case (*Answer, page 8, last paragraph*).

It is the duty of Examiners to further the prosecution of applications, not to wrap them in chains and millstones. The MPEP says as much, in many places. The Examiner knew of Appellants' interpretation of the claim, and should have been able to discern its plain meaning from ordinary principles of English grammar. If he believed that the language could mean something else, i.e. is ambiguous, then he had a duty to discuss this with Appellant's attorney or to reject the claim under 35 U.S.C. § 112 as indefinite. In the words of the MPEP:

If the Examiner wants the Applicant to improve the clarity or precision of the language used, the Examiner should suggest improved language to the Applicant. MPEP 2173.02 (Emphasis Added).

Moreover, the MPEP further states:

The Examiner's task of making sure the claim language complies with the requirements of the statute should be carried out in a positive and constructive way, so that minor problems can be identified and easily corrected. MPEP 2173.05(e) (Emphasis Added).

Here, Appellants amended their claims in view of the prior art; the amendment was clear on its face; the Appellants even explained the purpose of the claim amendments and the meaning of the claim as amended. Appellants were then blindsided by a Final Rejection, by a claim interpretation which makes no sense, grammatically or procedurally; an interpretation which is not only grammatically incorrect, but which, if it were correct, would give the claim exactly the same meaning after amendment as before! As the Examiner himself indicated, no further amendment would have been entered After Final, and thus Appellants would be forced to appeal or to file an RCE, without having been given an opportunity to contest the incorrect construction or to further amend the claim by right. This is manifestly unfair, and is contrary to both the aims of the patent system as well as the clear mandate of the MPEP. At the very least, the Examiner should have suggested clarifying claim amendments (MPEP 2173.02) or rendered the rejection non-final, providing Appellants an opportunity to amend the claims. As the MPEP states in § 2173.06:

[w]here there is uncertainty as to the proper interpretation of a claim, it is not proper to reject the claim over the part art.

Yet, that is exactly what was done.

Even were the grammatical construction not by itself dispositive, the claims must still be read to require that partly hydrolyzed EVA copolymers be employed as protective colloids both during polymerization and during drying, because Appellants have stated this to be the proper interpretation of the claim.² To ignore Appellants' construction is improper and contrary to binding precedent. In the *ex parte* prosecution of the *Zletz* polypropylene application, Serial No. 03/462,480, *Zletz* presented claims 13 and 14 which were rejected by the Examiner and affirmed by the Board, based on a claim interpretation which was not the

² An interpretation which is both reasonable and consistent with the specification.

same as the inventor had stated during prosecution. The CCPA reversed, *In re Zletz*, 893 F.2d 319, 321; 13 USPQ 2d 1320, 1322 (Fed. Cir. 1989), stating:

When the Appellant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the Appellants' invention and its relation to the prior art. *Zletz* at 321.

The Court went on to state that:

It was incorrect for the Board to read unwritten limitations into claims 13 and 14, limitations , contrary to the plain words of the claims, and CONTRARY TO THE INTERPRETATION THAT THE INVENTOR HIMSELF PLACED ON THE CLAIMS. Claim 13, according to *Zletz*, does not require that the polymer consist essentially of recurring propylene units or that the crystalline content be substantial; and claim 14 requires neither crystalline content nor, according to *Zletz*, that the polypropylene be a homopolymer.³

Zletz at 321. (Emphasis and Upper Case added).

Thus, the issue in *Zletz*, an interpretation by the Examiner contrary to the plain wording of the claims, is the same issue here. The CCPA resolved that issue by requiring the Office to accept the meaning "the inventor himself placed on the claims". The same holds true here. Both the plain meaning of the claim as well as the interpretation Appellants placed on the claim at the time of the amendment require that a partly hydrolyzed EVA copolymer be

³ None of the statements by *Zletz* referred to by the Court are present in the specification of U.S. Application Serial No. 03/462,480, as indicated by a review of the corresponding published Canadian application, CA 998497 (October 12, 1976; filed August 30, 1955), which claims priority to U.S. 462,480 filed October 15, 1954. The statements the Court refers to are statements by the inventor during prosecution, i.e. part of the intrinsic evidence the Federal Circuit refers to in interpreting claim scope, but in an *ex parte* setting.

used both during polymerization and also be added prior to drying. This is what the claim says. That is what Appellants state the claim says. That is how the claim must be interpreted. *In re Zletz, Id.*

The Examiner goes on to state:

. . . the fact that “colloids” as opposed to “colloid” is used in the last line of claim 1 is insignificant. . . Either of the protective colloids used can individually be termed as protective colloids.

One problem with the Examiner’s argument is that he has now changed the claim language. The claim does not recite using a protective colloids during polymerization, or further protective colloids during spray drying. The singular, not the plural, is used in each instance.

Claims recite the necessary steps, ingredients, etc., which are required minimally to infringe the claim. The language in a claim is self-contained; it refers to those necessary steps, ingredients, etc., and not to others which might (or might not) be present. Claims are a single sentence. The present claim requires using a particular protective colloid during polymerization and the same type (partly hydrolyzed EVA copolymer) during drying (added prior to drying). This interpretation is mandated by the use of the singular “colloid” in these instances, and the use of “colloids” in defining what both colloids are (note a plural verb is also used). This language is internally consistent.

It is true that another protective colloid or other protective colloids can be used in each step. However, this colloid or these colloids must still be used in conjunction with a partly hydrolyzed EVA copolymer in each step. This is what the claim requires. Addition of unclaimed protective colloids is allowed by the “comprising” transitional phrase, as is the case in all such claims. The internal language of the claims however, is not tailored to unclaimed

but permissible ingredients; it is specific to the necessary ingredients recited in the claim. The claim means what Appellants say it means.

The Examiner also accuses Appellants of “reading limitation[sic] into the claims that are simply not there.” *Answer, page 7*. Rather, the reverse is true. Every limitation which Appellants state is in the claim, is in the claim, *in ipsius verbis*. Appellants are not importing any limitations.

Claim 11 requires that partly hydrolyzed EVA copolymers are the sole protective colloids employed. The Examiner made no comment with respect to this claim. This preferred embodiment precludes the use of any other protective colloid in addition to the EVA copolymer protective colloids which are necessarily used in polymerization and drying. The description of the prior art by the Examiner acknowledges that none of the references teach using an EVA copolymer protective colloid as a spraying assistant during drying. There can be no issue of interpretation of claim 11. Claim 11 is clearly novel as well.


It is noted that the rejections are cumulative, the *Weitzel* and *Mayer* EP applications (in the German language) also having been cited as their U.S. counterparts (English language).

Withdrawal of the rejections of the claims over *Nakamae* et al. is acknowledged.

Reversal of the rejections of record is solicited.

Respectfully submitted,

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